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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,245	08/21/2002	Toshihiro Sadaoka	50069-11	4541
20277 7590 03/03/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
CHOI, FRANK I				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
03/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,245

Applicant(s)

SADAOKA ET AL.

Examiner

FRANK I. CHOI

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/23/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Period for Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-137336 in view of EP 0 393 723, the acknowledged prior art, JP 63188628 and JP 63027411.

The claimed invention is directed to a sebum absorbing paper which a basis weight of 5 to 25 g/m², containing an inorganic filler containing hydroxyapatite and talc having an average particle size of 0.5 to 8 micrograms and said sebum absorbing paper has a punch force of 5.0 or more.

JP 11-137336 discloses a paper used to absorb sebum from the skin containing inorganic filler in the amount of 0.5% to 40-part weight %, such as talc having an average particle size of 1.2 microns where the basic weight of the paper is in the range of 15-25 g/m² (Paragraphs 0021, 0023, 0048). It is disclosed that transparency after absorption of sebum is high (Paragraph 0062).

EP 0 393 723 discloses papers and nonwoven fabrics carrying or incorporating calcium phosphate compounds in the form of powders, granules or porous granules, having a particle size of 0.1 to 30 microns (Pg. 6, lines 7-15). It is disclosed that the paper contains 10 to 80% by weight of the calcium phosphate compound as a filler (Pg. 8, lines 43,44). It is disclosed that hydroxyapatite is a suitable calcium phosphate compound (Pg. 8, lines 44,45). It is disclosed that

the calcium phosphate compound is generally solely used as a filler in the functional paper, however, if desired, it may be used together with conventional fillers such as talc (Pg. 9, lines 8-10). It is disclosed that preferably the functional paper shows a basis weight of 20 g/m² or more (Pg. 9, line 40). It is disclosed that the functional paper can be used to adsorb any oil-soluble substances which could not be adsorbed with an activated carbon (Pg. 4, line 58, Pg. 5, line 1). It is disclosed that the functional paper can be used in diapers, sanitary napkins and pads for bedsores (Pg. 9, lines 45-50).

The Applicant acknowledges that the skin surface, in particular around the nose and chin and middle of the forehead, tends to be oily due to the frequent secretion of sebum. It is disclosed that the human skin is damaged by oxidized sebum generated by its exposure to the air while the time passes after its secretion. (Specification, Page 1).

JP 63027411 discloses that hydroxyapatite is effective in eliminating skin lipid byproducts that have an adverse effect on the skin and that hydroxyapatite powder demonstrates excellent selective absorption of peroxidized lipids (See Page 3 of translation of 63027411).

JP 63188628 discloses that lipid peroxides produced by oxidative deterioration cause rough skin and acne inflammation and that hydroxyapatite absorbs these sebaceous waste products (See Page 6 for translation of 63188628).

JP 11-137336 discloses a paper used to absorb sebum from the skin containing inorganic filler in the amount of 0.5% to 40-part weight %, such as talc having an average particle size of 1.2 microns where the basis weight of the paper is in the range of 15-25 g/m² and that transparency after absorption of sebum is high. The difference between JP 11-137336 and the claimed invention is that the prior art does not expressly disclose a sebum absorbing paper used for

applying to skin or for cleaning skin which also contains hydroxyapatite. However, the prior art amply suggests the same as it is known in the art to use papers containing hydroxyapatite and talc as absorbants (See JP 11-137336, JP 63027411 and JP 63188628), papers having a basis weight of 15-25 g/m² containing talc are known to be used for absorbing sebum/oil from the skin (See JP 11-137336) and that hydroxyapatite is used in cosmetic products to selectively absorb oxidized lipids (See JP 63188628). As such, one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper having a basis weight of 15-25 g/m² containing hydroxyapatite and talc would be suitable for selectively absorbing oxidized sebum from the skin because hydroxyapatite powders are known to be effective in selectively absorbing oxidized lipids from the skin and papers having a basis weight of 15-25 g/m² are disclosed as suitable for use in absorbing sebum and oil from the skin. With respect to the limitation of "punch force of 5.0 or more", according to the Applicant's specification "punch force" is a measure of the absorbency of paper by measuring the light transmission before and after use. A search of the art by the Examiner did not show the use of the term "punch force" or the light spectrophotometer (EPR-80WX) in relation to lipid absorbency. However, the prior art does disclose that high transparency after absorption of sebum is desired. Since the "punch force" is simply a measure of the transparency after use and high transparency is desired after use in the prior art and the Office is not in a position to test the prior art paper, the burden falls on the Applicant to show that the high transparency desired in the prior art does not equate to the "punch force of 5.0 or more".

The Examiner had duly considered Applicant's arguments but deems them moot in light of the new grounds of rejection herein.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a compressed schedule and may be reached Monday, Tuesday, Wednesday and Thursday, 6:00 am – 4:30 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Johann R. Richter, can be reached at (571)272-0646. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank Choi
Patent Examiner
Technology Center 1600
March 4, 2010

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616